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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/602,212	06/23/2000	Ursula Buchholz	15280-398100US	9937
7590 03/10/2004				
JEFFREY J KING, ESQ. GRAYBEAL JACKSON HALEY LLP 155-108 th Avenue, N.E. Suite 350 Bellvue, WA 98004-5901		EXAMINER CHEN, STACY BROWN		
		ART UNIT PAPER NUMBER 1648		

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/602,212

Applicant(s)

BUCHHOLZ ET AL.

Examiner

Stacy B Chen

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1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-101 is/are pending in the application.
- 4a) Of the above claim(s) 48-56 and 88-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47, 57-87 and 90-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed December 29, 2003 is acknowledged and entered. Claims 1-101 are pending. Upon further consideration, some previously withdrawn claims are rejoined so that claims 1-47, 57-87 and 90-101 are examined. Claims 48-56 and 88-89 remain withdrawn from consideration. The rejection of claims 1-29, 46, 47, 57-82, 85-87, 90-92, 95 and 98-99 under 35 U.S.C. 112, first paragraph, is withdrawn in view of Applicant's amendment.

Specification

2. The specification is objected to for claiming the benefit of a prior-filed copending nonprovisional application without identifying the relationship of the instant application to the prior-filed copending application (CFR 1.78). Presently, the priority statement in the specification states that it claims priority to USSN 09/847,173, but does not identify whether it is a continuation, continuation-in-part or divisional.

Double Patenting

3. Claims 1-47, 57-87 and 90-101 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 11 and 22 of U.S. Patent No. 6,264,957. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent are a species of the genus instantly claimed.

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4. Claim 42 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 30 of U.S. Patent No. 6,699,476. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims and the co-pending claims are drawn to a human-bovine chimeric RSV comprising a heterologous polynucleotide encoding an immune modulatory molecule.

5. Claims 1-47, 57-87 and 90-101 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47, 57-87 and 90-101 of copending Application No. 10/030,951. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are a species of the copending application's genus claims. The instant claims are drawn to an obvious species of a chimeric RSV comprising a M2ORF1 polymerase elongation factor. The copending claims are drawn to a chimeric RSV comprising a polymerase elongation factor. It would have been obvious to use the M2ORF1 polymerase elongation factor as taught by the instant specification, page 20, lines 4-6, which discloses only one polymerase elongation factor, M2ORF1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 36-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39-49 of copending Application No. 09/611,829. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims and the co-pending claims are

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drawn to a human-bovine chimeric RSV comprising a partial or complete deletion/ablation of M2ORF2.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 42 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 30-42 and 68 of copending Application No. 10/031,095. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are a species of the copending application's genus claims. The instant claims are drawn to an obvious species of a human-bovine chimeric RSV comprising a M2ORF1 polymerase elongation factor. The copending claims are drawn to a human-bovine chimeric RSV comprising a polymerase elongation factor. It would have been obvious to use the M2ORF1 polymerase elongation factor as taught by the instant specification, page 20, lines 4-6, which discloses only one polymerase elongation factor, M2ORF1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. No claim is allowed.

Papers relating to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 located in Crystal Mall 1. The Fax number for Art Unit 1648 is (703) 872-9306. All Group 1600 Fax machines will be available to receive

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transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Stacy B. Chen, whose telephone number is (571) 272-0896. The Examiner can normally be reached on Monday through Friday from 7:30 AM-4:00 PM, (EST). If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, James C. Housel, can be reached at (571) 272-0902. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SBC

Stacy B. Chen
March 2, 2004

James C. Housel
3/8/04

JAMES HOUSEL
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